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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/237,896

Applicant(s)

OTSUKA ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 38-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 12-37 is/are rejected.
- 7) ☒ Claim(s) 9-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is responsive to response filed on September 19, 2002.

Response to Applicant's Remarks

1. Applicant remarks that Meister fails to disclose an image data memory that includes a plurality of memory boxes each assigned a previously determined box number.

Meister teaches "memory means connected to said digital means for storing a facsimile document and identifying data being associated with said facsimile document" and "control means ...directs said memory means to store said facsimile document only after having requested the sender to input an identification number and having received the identification number from the sender which is to be associated with said facsimile document ...directs said memory means to forward said previously stored facsimile document to a recipient only if an identification number supplied by a recipient matches the identification number created by the sender associated with said previously stored facsimile document and only if said previously stored facsimile document has not been previously been forwarded to a recipient." (col. 17, lines 5-33). Meister further teaches the security code, facsimile message number, docket numbers or billing information codes for the stored document (col. 10, lines 24-39). Thus, each document is stored as a file in a memory box of the memory wherein the box number can be sender's identification number, security code and/or facsimile message number. In addition, Von Meister teaches the judgment whether the memory box of each document file is valid or invalid by comparing the received information with the memory box (col. 13, line 53 – col. 16, line 54).

The rejection of claims 1-8, 11-37 is maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 11-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Meister (US Patent No. 5,452,099).

Concerning claims 1-3, 11, 12-16, 22-24, 36-37, Von Meister discloses a facsimile device comprising an image data memory for storing image data; a plurality of memory boxes provided in the image data memory, each of the boxes being accompanied with a predetermined box number and storing first image data therein; a detection device for detecting a transfer command arrived to the facsimile device, specifying a memory box and instructing transfer of the first image data to a calling side; a judgment device for judging whether or not the memory box specified by the transfer command using the box number detected by the detection device is effective; an image transfer device for transferring the first image data stored in the specified memory box to the calling side when the judgment device judges that the memory box specified by the transfer command is valid and alternatively for transferring second image data different from the first image data to the calling side when the judgment device judges that the memory box specified by the transfer command is not valid (Figs. 1-8; col. 8, line 58 – col. 10, line 53; col. 11, line 59 – col. 12, line 59; col. 13, line 1 – col. 16, line 9); col. 17, lines 5-33).

Von Meister does not directly teach the judgment of the effectiveness of the memory box or of the existence of the memory box. However, Von Meister teaches the judgment whether the memory box is valid or invalid or the memory box is unique or not. It would have been obvious to one skilled in the art at the time the invention was made to consider the judging of the validity of the memory box in Von Meister equivalent to the judging of the effectiveness or existence of the memory box as claimed since both of the processes do the same thing.

Von Meister does not specifically teach that the second image data is sent to the calling side when the memory box stores no image data, wherein the second image data indicating an operational manual. However, Von Meister teaches the step of “explain system operation and prompt for further input” 114 (Fig.2B) and if user ask for further information on the system, it send information explaining in detail system operation and prompt for the caller’s fax number and send more information to the caller (Figs.2B, 2C). In addition, the caller can ask for “detail reporting option” (120, Fig.2B) and the system will send information explaining the call “detail reporting option” or a program to generate monthly reports (Fig.2D), (col. 9, line 12 – col. 10, line 53). It would have been obvious to one skilled in the art at the time the invention was made to consider the operation manual of the system in Von Meister as the second image data as claimed since the caller can request it in any case he fails to have a communication with the system and the operation manual is different from the first image data stored in the memory. In addition, although Von Meister does not specifically teach that the operation manual includes at least a method of specifying the box number and the identification number or information registered in each of the memory boxes, it would have been obvious to one skilled in the art at the time the invention was made to include the method of specifying the box number and the

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identification number since the operation manual is supposed to provide instructions to operate the facsimile device.

Concerning claims 4-8, 17-21, 25-35, Von Meister further teaches that the memory box includes a plurality of confidential boxes and non-confidential boxes wherein each of the confidential boxes is accompanied with the box number and an identification number while the non-confidential boxes is accompanied with only the box number; the transfer command includes information of the box number and telephone number of the calling side, and with confidential boxes and additional identification number; the judgment judges whether or not the identification number assigned to the confidential box coincides with the identification number included in the transfer command for confidential box; a message data memory for storing in advance a plurality of message data such as messages indicating that the combination is not unique and have the sender re-enter the security code (Fig.5), error message (306, Fig.6A), requesting for inputting the security code again (320, Fig.6A, 352, Fig. 6C), inputting message number again (340, Fig.6B, 804, Fig.7A), generating "message delivered" (362, Fig.6C), (Figs. 1-8; col. 8, line 58 – col. 10, line 53; col. 11, line 59 – col. 12, line 59; col. 13, line 1 – col. 16, line 9); col. 17, lines 5-33).

Allowable Subject Matter

4. Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Applicant's arguments filed on September 19, 2002 have been fully considered but they are not persuasive.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

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A handwritten signature in cursive script, reading "Anh Vinh Nguyen". The signature is written in black ink on a white background.

Madeleine AV Nguyen
Primary Examiner
Art Unit 2622

AV

November 27, 2002